

10/31/01

Hearing:
October 2, 2001

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 11
HRW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Johnson & Johnson

Serial No. 75/635,974

Jennifer L. Dean and Adam Barea of Drinker Biddle & Reath
L.L.P. for Johnson & Johnson.

Verna Beth Ririe, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Hairston, Chapman and Wendel, Administrative
Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Johnson & Johnson has filed an application to register
the mark HURT-FREE for "self-adhering tape for use in first
aid."¹

Registration has been finally refused on the ground
that the proposed mark is merely descriptive under Section
2(e)(1) of the Trademark Act. Both applicant and the

¹ Serial No. 75/635,974, filed February 8, 1999, based on an
allegation of a bona fide intention to use the mark in commerce.

Examining Attorney have filed briefs and both participated in an oral hearing.

The Examining Attorney maintains that the proposed mark HURT-FREE merely describes a significant feature or characteristic of applicant's self-adhering tape, i.e., that this is a self-adhering tape that will not hurt the user when it is removed. The Examining Attorney has introduced dictionary definitions of the words "hurt" and "free"² as support for the position that HURT-FREE immediately conveys the idea that the tape does not subject the user to pain or hurt upon removal, or that the user will be "free" of "hurt".

As evidence that users of first-aid tapes are concerned about using a tape that will not hurt, the Examining Attorney has made of record excerpted articles retrieved from the Nexis database which demonstrate that the public often associates the removal of bandages, and particularly adhesive bandages, with "hurt." Thus, the Examining Attorney argues, "a person utilizing self-

² The definitions include:

hurt, verb	to cause physical damage or pain to
hurt, noun	something that hurts; a pain, an injury, or a wound
free	not affected or restricted by a given condition or circumstance; not subject to a given condition

The American Heritage Dictionary of the English Language (3rd ed. 1992).

adhering tape would desire to 'not be affected by' or to be 'free' of this 'hurt'." As evidence of the descriptive nature of the term FREE when used in conjunction with a condition whose absence is a desirable characteristic or feature, the Examining Attorney has made of record copies of several third-party registrations in which the "-FREE" portion of the mark is either disclaimed or the mark as a whole is registered on the Supplemental Register. Copies have also been made of record of registrations on the Supplemental Register for the marks OUCHLESS and THE NO HURT TAPE for adhesive bandages and bandaging tape, respectively.

Applicant argues that, even assuming the individual terms "hurt" and "free" are descriptive, HURT-FREE is a unique composite which applicant has inventively juxtaposed and which requires the consumer to make a mental leap to ascertain the nature of applicant's goods. Applicant contends that its mark HURT-FREE is even more unique because of its unusual grammatical construction, in that most "-FREE" marks use nouns as the prefix, whereas applicant's mark uses a "verb-FREE" structure.

Applicant further argues that HURT-FREE has a double meaning in connection with its goods which precludes its being merely descriptive. Applicant insists that its mark

suggests a beginning-to-end pain relief; and that the mark connotes the totality of pain relief to be obtained through use of its product from the time of application to the final removal. Thus, according to applicant, consumers would be just as likely to associate HURT-FREE with the overall objective of the product as with the painless removal of the tape.

Finally, applicant argues that the excerpts retrieved from the Nexis database relied upon the Examining Attorney do not support her position because none of the articles use the term "hurt-free" in a descriptive manner or even as an expression, and because none of the articles are concerned with the removal of self-adhering tape such as applicant's but rather are directed to the pain of removing adhesive bandages.

A term is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys information about a characteristic or feature of the goods or services with which it is being used or is intended to be used. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). Whether or not a particular term is merely descriptive is determined not in the abstract, but rather in relation to the goods or services for which registration

is sought, the context in which the designation is being used, and the significance the designation is likely to have to the average purchaser as he or she encounters the goods or services bearing the designation, because of the manner in which it is used. See *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is not necessary that the term describe all the characteristics or features of the goods or services in order to be merely descriptive; it is sufficient if the term describes one significant attribute thereof. See *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991).

We find no difference in connotation for the composite term HURT-FREE from the combination of the common meanings of "hurt" and "free" as individual words. A "hurt-free" self-adhering bandage would be perceived by consumers as one which does not subject the user to pain or hurt. Furthermore, the excerpted articles retrieved from the Nexis database show that consumers are acutely aware of the pain or hurt normally associated with the removal of bandages. Thus, the use of the term HURT-FREE with a first-aid bandage which does not inflict pain because of the particular self-adhering properties of the bandage immediately and succinctly conveys this information to potential consumers.

We do not believe a viable distinction can be made on the basis of the term HURT-FREE being a combination of "verb-FREE" as opposed to "noun-FREE." In the first place, "hurt" can function as either a noun or a verb and HURT-FREE could be viewed in either way. But even more relevant, the message conveyed by the term HURT-FREE has the same descriptive significance, regardless of the grammatical construction. It takes no mental gymnastics to ascertain that an important feature of the goods with which the term is being used is that they are "hurt-free."

Applicant's further argument that its mark is only suggestive of the beginning-to-end pain relief which its self-adhering bandage provides is highly speculative. In view of the association which has been shown to exist between bandages in general and the pain in removal thereof, we find it highly unlikely that consumers would go beyond the immediate significance of the term HURT-FREE as an indication of the absence of pain in the removal stage. Regardless of any beneficial effects of the bandages throughout the healing process, the freedom from hurt in the final removal would be a most important attribute of the product in the eyes of most consumers.

Although the Examining Attorney may not have found instances of use of the exact phrase "hurt-free" by others,

this is far from controlling. The fact that applicant may be the first or only user of the term "hurt-free" does not justify registration if, as we have found here, the term projects only merely descriptive significance. See *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018 (TTAB 1983). Applicant's self-adhering first-aid bandage is by its very nature generally free from pain in removal, since it does not stick to skin or hair, as do adhesive bandages, and the term HURT-FREE merely describes this significant feature or characteristic of applicant's product.³

Accordingly, we find that HURT-FREE would be merely descriptive if used as intended with applicant's self-adhering tape for use in first aid.

Decision: The refusal to register under Section 2(e)(1) is affirmed.

³ Applicant's argument that other "-FREE" marks have been registered by the Office is to no avail. The question here is the descriptiveness of the proposed mark with respect to these particular goods. Whether or not other "-FREE" marks for totally unrelated goods have been registered is irrelevant.

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